

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Initially Applicants note that the references JP 5-325500, JP 11-242873, JP 2003-68060, and WO 01/86652, cited in the Information Disclosure Statement (IDS) filed July 22, 2005, have not been initialed as being considered by the Examiner. It is respectfully requested that these references be considered, as discussed during a telephone conversation with Examiner Vu on July 21, 2008.

Claims 1-28 are currently pending. Claims 1, 5-9, 12, and 15-18 have been amended; and Claims 19-28 have been added by the present amendment. The changes and additions to the claims are supported by the originally filed specification and do not add new matter.¹

In the outstanding Office Action, Claim 1 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; Claims 1, 2, and 4-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0117547 to Ogihara et al. (hereinafter “the ‘547 application”) in view of U.S. Patent No. 6,469,239 to Fukuda (hereinafter “the ‘239 patent”); and Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘547 application in view of the ‘239 patent and U.S. Patent Application Publication No. 2001/0047317 to Yodo (hereinafter “the ‘317 application”).

Applicants respectfully traverse the rejection of Claim 1 under 35 U.S.C. § 112, first paragraph. The outstanding Office Action asserts that the claimed limitation “a reproducing apparatus having an insufficient memory capacity accesses said supplementary data included in the contents file” in Claim 1, contains subject matter which was not described in the instant

¹ See, e.g., page 8, line 2 to page 9, line 15 of Applicants’ specification.

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.²

However, it is noted that M.P.E.P. § 2163.02 provides that:

[w]henver the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement.

It is respectfully submitted that the originally filed specification conveys with reasonable clarity to those skilled in the art, as of the filing date sought, that Applicants were in possession of the invention as now claimed.³ For a non-limiting example, it is noted that the originally filed specification discloses that, since the fringe data are included in the audio data having digital audio data, the fringe information may be displayed even if the system memory capacity is small.⁴ Thus, it is respectfully submitted that one of ordinary skill in the art would recognize that Applicants were in possession of the reproducing apparatus, as now claimed.

Accordingly, it is respectfully requested that the rejection of Claim 1 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Amended Claim 1 is directed to a computer-readable storage medium, comprising:

a contents area configured to record a contents file, the contents file including contents data and supplementary data corresponding to said contents data;

a database area configured to record a database file, the database file including said supplementary data corresponding to said contents data included in the contents file,

² See Office Action dated July 2, 2008, page 4.

³ See, e.g., page 14, line 3 to page 16, line 19 of Applicants' specification.

⁴ See, e.g., page 16, lines 16-19 of Applicants' specification.

wherein a reproducing apparatus having an insufficient memory capacity accesses said supplementary data included in the contents file, and a reproducing apparatus having a sufficient memory capacity accesses said supplementary data included in said database file.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the '547 application is directed to a method of transmitting a command to reproduce an audio-only disk-shaped recording medium to a device driver on the basis of a request from application software.⁵ In particular, the '547 application discusses a file configuration created by an audio CD file system including a disk/track information file, a CD-text information file, and audio data files.⁶

The outstanding Office Action cites the audio data files in the file list shown in Figure 6 of the '547 application for teaching the claimed contents area configured to record a contents file, as defined in Claim 1. Specifically, the Office Action asserts that "the file name and the data size of the ['547] audio data file clearly encompasses the supplementary data corresponding to said content data."⁷ Further, the Office Action cites the '547 disk/track information file, illustrated in Figure 7, for teaching the claimed database area configured to record a database file.

However, it is respectfully submitted that the '547 application fails to disclose a contents area configured to record a contents file, the contents file including contents data and supplementary data corresponding to said contents data. Rather, the '547 application discusses that the file list shown in Figure 6 corresponds to a result of mounting a CD-DA on which 14 audio tracks are recorded. Each file shown in the list of Figure 6 presents file attributes in accordance with the Linux OS.⁸ The '547 application discusses that each of the audio data files is provided with a file name corresponding to a track number recorded on a

⁵ See '547 application, paragraph [0001].

⁶ Id., see Figure 6.

⁷ See Office Action dated July 2, 2008, page 3.

⁸ See '547 application, paragraphs [0148] and [0149].

CD-DA, such as a file name of track01.cda to track14.cda. As noted in the Office Action, the list items of the audio data files show data size as an attribute.⁹ The '547 application discusses that **the data size information can be generated from the TOC information** recorded on the CD-DA.¹⁰ The '547 application does not disclose that the audio data files **include the attributes** such as the data size information cited in the Office Action. Further, the '547 application simply discusses that each of the audio data files is provided with a file name **corresponding to a track number** recorded on the CD-DA.¹¹ The '547 application does not disclose that the '547 file name is **supplementary data corresponding to the audio data**. Thus, the '547 application fails to disclose the contents area defined in Claim 1.

Further, it is respectfully submitted that the '547 application fails to disclose a database area configured to record a database file, the database file including said supplementary data corresponding to said contents data included in the contents file. Rather, the '547 application simply discusses that the disk/track information file is roughly divided into disk information and track information. The '547 disk information is an area **for storing information on the data as a whole** recorded on the CD-DA, and the track information is an area for **storing required additional information on each audio track file** (e.g., information of emp, data, no copyright, and audio_ch, as shown in Figure 7).¹² The '547 application does not disclose that the disk information area or track information area **stores the file name or the data size**, cited in the Office Action. Further, the '547 application does not disclose that the disk information area or track information area stores supplementary data corresponding to the audio data **included in the audio data file**. Thus, the '547 application does not disclose the database area defined in Claim 1.

⁹ See '547 application, paragraph [0155].

¹⁰ Id. at paragraph [0156].

¹¹ Id. at paragraph [0155].

¹² Id. at paragraphs [0160] through [0170].

Moreover, it is respectfully submitted that the '239 patent fails to remedy the deficiencies of the '547 application, as discussed above. The '239 patent is directed to a data storage apparatus and data storage method with quality degrading features. However, it is respectfully submitted that the '239 patent fails to disclose a contents area configured to record a contents file, the contents file including contents data and supplementary data corresponding to said contents data; and a database area configured to record a database file, the database file including said supplementary data corresponding to said contents data included in the contents file. Further, the Office Action does not rely on the '239 patent for such teachings.

Thus, no matter how the teachings of the '547 application and the '239 patent are combined, the combination does not teach or suggest the contents area and database area defined in Claim 1. Accordingly, it is respectfully submitted that Claim 1 (and all associated dependent claims) patentably defines over any proper combination of the '547 application and the '239 patent.

Amended Claim 5 recites, in part,

recording, on a predetermined recording medium, a contents file including contents data and supplementary data corresponding to said contents data; and

recording, on said predetermined recording medium, a database file including said supplementary data corresponding to said contents data included in said contents file.

Amended Claim 6 recites, in part,

recording means for recording, on a predetermined recording medium, a contents file and a database file, said contents file including contents data and supplementary data corresponding to said contents data, and said database file including said supplementary data corresponding to said contents data included in said contents file.

Amended Claim 7 recites, in part,

readout means for reading out supplementary data stored in a contents file from a recording medium having recorded thereon said contents file and a database file, said contents file including contents data and said supplementary data corresponding to said contents data, and said database file including said supplementary data corresponding to said contents data included in said contents file.

Amended Claim 9 recites, in part,

readout means for reading out supplementary data stored in a database file, from a recording medium having recorded thereon a contents file and said database file, said contents file including contents data and said supplementary data corresponding to said contents data, and said database file including said supplementary data corresponding to said contents data included in said contents file.

Amended Claim 12 recites, in part,

readout means for selectively reading out, from a recording medium having recorded thereon a contents file and a database file, supplementary data included in said contents file and the supplementary data included in said database file, said contents file including contents data and said supplementary data corresponding to said contents data, and said database file including said supplementary data corresponding to said contents data included in said contents file.

As noted above, the '547 application and the '239 patent, alone or in proper combination fail to disclose the contents area and database area recited in Claim 1. Thus, the '547 application and the '239 patent fail to disclose the recording method and recording apparatus recited in Claims 5 and 6, respectively. Further, the '547 application and the '239 patent fail to disclose the reproducing apparatus recited in Claims 7, 9, and 12, respectively. Accordingly, it is respectfully submitted that Claims 5-7, 9, and 12 (and all associated dependent claims) patentably define over any proper combination of the '547 application and the '239 patent.

Amended Claims 15-18 recite limitations analogous to the limitations recited in Claims 6, 7, 9, and 12, respectively, but in non-means plus function format. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claims 6, 7, 9, and 12, it

is respectfully submitted that Claims 15-18 patentably define over any proper combination of the '547 application and the '239 patent.

Regarding the rejection of Claim 3 under 35 U.S.C. § 103(a), it is respectfully submitted that the '317 application fails to remedy the deficiencies of the '547 application and the '239 patent, as discussed above. Further, the Office Action cites the '547 CD-text information for teaching an album name, name of an artist, and a title name of each track.¹³ However, it is noted that Fig. 6 of the '547 application illustrates that **the CD-text information file is distinct from the disk/track information file and audio data files**, cited in the Office Action to teach the claimed contents area and database area defined in Claim 1. That is, the '547 application does not disclose that the disk/track information file and audio data files include the CD-text information. Thus, the '547 application does not disclose *supplementary data that includes data of a title, an artist's name, and an album name*, as defined in Claim 1. Accordingly, it is respectfully submitted that dependent Claim 3 patentably defines over any proper combination of the '547 application, the '239 patent, and the '317 application.

The present amendment also sets forth new Claims 19-28 for examination on the merits. No new matter has been added. It is noted that these more detailed features are not disclosed or suggested by the applied references.

Thus, it is respectfully submitted that independent Claims 1, 5-7, 9, 12, and 15-18 (and all associated dependent claims) patentably define over any proper combination of the '547 application, the '239 patent, and the '317 application.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as

¹³ See Office Action dated July 2, 2008, page 28 and 29.

amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

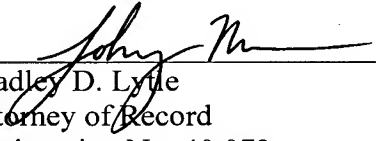
Respectfully submitted,

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